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10/070,801	06/10/2002	Jean-Paul Dumortier	324-142	2880

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EXAMINER

BARON, HENRY

ART UNIT	PAPER NUMBER
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2616

MAIL DATE	DELIVERY MODE
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08/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/070,801

Applicant(s)

DUMORTIER ET AL.

Examiner

Henry Baron

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) ✓
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Response to Arguments/Remarks

1. Applicant's arguments filed 4/18/2007 have been fully considered but they are not fully persuasive.
2. Examiner accepts the Applicant arguments regarding Claims 8, 9-11 with regards to U.S.C. 112 and withdraws the rejection.
3. Applicant argues that Fraser discloses transferring (b) confidential data, such as the customer's credit card number (CCN), between the first terminal (customer) and third terminal (transaction manager) before connecting (c) the first terminal (customer) to the second terminal (vendor) and thus fails to disclose setting up a link between the first terminal (customer) and a third terminal (transaction manager) during the call between the first terminal (customer) and second terminal (vendor).
4. After a careful reading of Fraser (8: [0030-0050]), the Examiner disagrees with Applicant's reading. In 8: [0030], Fraser teaches that customer employ communication system to call vendor. This connection is maintained throughout the transaction process – even when transaction manager uses a digital voice message to ask customer for the CCN and when the customer uses the touch-tone channel to respond.
5. The Examiner agrees that in Fraser, the (transaction manager) third terminal is activated when the first terminal (customer) calls the second terminal (vendor), and third terminal (transaction manager) plays an active role in the transaction.
6. However, this obvious variation renders the rejection a 103(a), since it would be obvious to configure the system where the initial call is between first terminal (customer) and the second terminal (vendor) with the motivation provided below.
7. In this context and upon further examination, the objection to Claim 7 is withdrawn.
8. Applicant argues that Gore fails to cure the foregoing deficiency in Fraser. Gore, discloses an ISDN network wherein a terminal system 300 (business) receives credit information from a customer on a B channel and receives and sends credit information and a validation on a signaling D-channel. But the

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combination of Fraser and Gore i.e. using the B-channel and D-channel of Gore in the Fraser connection between the three terminals does not result in the equipment of method Claim 1 or the arrangement claim

9. The Examiner does not concur. The modification of Fraser with Gore provides a more flexible embodiment of the transaction network.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 7 - 10, and 12 -13 are rejected under 35 U.S.C. 103(a) as being anticipated by Fraser (U.S. Patent 5,329,589).

12. Regarding Claims 1, 9, and 10, Fraser discloses a method of validating an operation during a call set up between first terminal and second terminal via a digital telecommunication network, said call using a logical channel of a digital multiplex link including another logical channel to carry data (Figure 4), method comprising the following steps; during said call, setting up a link between said first terminal and a third terminal via said other logical channel of the digital multiplex link (column 8 lines 40-43), transferring between the first terminal and third terminal via said other logical channel, confidential data not accessible to said second terminal for validating said operation effected during said call between said first terminal and second terminal (column 8 lines 43-48), and sending an acknowledgement message confirming the validation of said operation from third terminal to the second terminal (column 8 lines 59-65).

13. However, Fraser fails to disclose during the call, setting up a link between second terminal and third terminal via network at the request of second terminal to request validation of said operation, then setting

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up a link between said first terminal and a third terminal via said other logical channel of the digital multiplex link. In Fraser, the (transaction manager) third terminal is activated when the first terminal (customer) calls the second terminal (vendor), and third terminal (transaction manager) plays an active role in all of the transactions.

14. However, it would have been obvious at the time the invention was made to a person having ordinary skill to modify Fraser so that initially, the call is set up solely between a first terminal (customer) calls the second terminal (vendor); then at the discretion of the second terminal (vendor) during the call, setting up a link between second terminal and third terminal via network at the request of second terminal to request validation of said operations.

15. The original Fraser configuration where the third terminal is connected throughout the transaction may be appropriate for a 'sure-sell' transaction e.g. hot-cakes, where the modified Fraser configuration would be appropriate for discretionary sales where the customer may or may not wish to complete the transaction.

16. With regards to Claim 7, 12 and 13, modified Fraser allows setting up a virtual circuit on a signaling channel between the second terminal and first terminal after the second terminal has received acknowledgement message from the third terminal.

17. Claims 2 -3, 5 -6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser (US 5,329,589) in view of Gore et al. (US 5,313,463).

18. With respect to claims 2 & 3, Fraser teaches all of the elements of Claim 1, but does not disclose the telecommunication network as an ISDN network.

19. Gore discloses an ISDN network used for communication between a business and a customer wherein the business and customer terminals communicate via a B channel and the D channel is used to validate customer information such as a credit card number by a third terminal (column 1 lines 46-68).

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Fraser and Gore are analogous art because they are from the same field of endeavor of validating customer information by a third terminal in a telecommunication network.

20. It would have been obvious at the time of the invention to a person of ordinary skill in the art to modify the business transaction teachings of Fraser with use an ISDN network teachings of Gore, using the B channel for communication between the customer and vendor and the D channel for validating customer information with a third terminal.

21. Fraser and Gore are analogous art from the field of endeavor of validating customer information by a third terminal in a telecommunication network.

22. This modification of Fraser by Gore would better facilitate the transaction between the terminals by introducing a signaling channel that can be used to validate customer information instead of using another data channel or a private line facility (column 3 line 64 - column 4 line 42). Subsequently, the first terminal and third terminal transactions will be more secure.

23. With respect to claim 5, Gore discloses wherein said step of setting up said link between said second terminal and third terminal includes opening a virtual circuit on a signaling channel (column 1 lines 46-68).

24. With respect to claim 6, Gore discloses wherein said link between said second terminal and third terminal and said call between said first terminal and second terminal are multiplexed on the same physical medium serving second terminal from said network (ISDN D and B channels described in Figure 2 and column 3 line 64 - column 4 line 42).

25. With respect to claim 8, Fraser discloses a communications system for validating an operation during a call set up between a first terminal and a second terminal via a digital telecommunication network (Figure 4 Elements 403 & 405), said call using a logical channel of a digital multiplex link including another logical channel to carry data comprising; another logical channel between a third terminal and said first terminal to exchange confidential data not accessible to said second terminal (column 8 lines 40-

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43); and a link between said third terminal and said second terminal to send an acknowledgement message confirming validation of said operation (column 8 lines 59- 65).

26. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fraser et al. (US 5,329,589) in view of Linehan (US 6,327,578 B1).

27. Fraser discloses the elements of Claim 10 where the third terminal is a credit manager connected to a credit card database, but not to a bank.

28. Linehan discloses validating an operation between a Consumer (Figure 4 Element 202) and a Merchant (Figure 4 Element 204), by a third terminal, the Consumer's Issuing Bank and Issuer Gateway (Figure 4 Elements 212 & 214) which issues an authorization token, including a reference to the Consumer's credit or debit card number, to the Merchant (column 6 lines 8-43).

29. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Issuer Gateway and Issuer Bank of Linehan in place of or in conjunction with the Credit Manager and Credit Card Database of Fraser.

30. This modification is advantageous because the Consumer/Customer has the option to use either a debit card or credit card.

Conclusion

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Baron whose telephone number is (571) 270-1748. The examiner can normally be reached on 7:30 AM to 5:00 PM E.S.T. Monday to Friday.

34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

35. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained

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from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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